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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,314	07/02/2001	Mi-Kyung Han	678-678 (P9666)	1738
28249	7590	04/01/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553				HONG, HARRY S
ART UNIT		PAPER NUMBER		
		2642		

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/897,314	HAN, MI-KYUNG	
	Examiner	Art Unit	
	Harry S. Hong	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 July 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 9, "the selected additional service" lacks antecedence. Is it referring to the first selected additional service or the second selected additional service?

Claim 2, line 2 recites the same defect as above.

Regarding claim 4, lines 2 and 3; and claim 5, lines 2 and 3, "the designated additional service" lacks antecedence.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 7, 8, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierce et al. (Pierce; US 5,666,364; cited and applied for the first time).

Claim 1, as best understood, reads on Pierce as follows. Refer to column 3, line 55 – column 4, line 43. The claimed first additional service reads on how the subscriber defines the service priority list (SPL) field (one can designate a DAP call or a MSC call as having the higher/lower priority). The claimed incoming call reads on the incoming call. The claimed selected second additional service reads on the current call. Thus, the claimed step of “maintaining the selected additional service when the first selected additional service is identical to the second selected additional service” is taught at column 4, lines 23 – 28. Since Pierce teaches, via a database lookup, informing the calling subscriber of a lower priority incoming call that the called party is busy, the current call has to be maintained.

The limitation of claim 2 is taught at column 5, lines 9 – 17.

The limitations of claims 4, 5, 7, and 8 are taught at column 4, line 64 – column 5, line 17. The claimed “during” reads on ‘on the fly’.

The limitations of claims 11 and 12 are taught at column 5, line 3, where the claimed function keys read on the disconnecting function.

Claims 13 and 14 read on Pierce in the same manner as claims 1 and 4 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce as applied above in view of Petty et al. (Petty; US 6,546,263; cited and applied for the first time).

Pierce is silent with respect to the display icons of claims 3, 6, 9, and 10. However, Pierce already teaches informing the user (see column 5, line 9) and Petty teaches displaying operating condition icons in a mobile telephone. Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to display the operating condition icons into the mobile telephone of Pierce as taught by Petty in order to allow the user to quickly and visually realize the status of the mobile telephone.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eriksson et al. teach a system and method for reconnecting a disconnected low priority call in a mobile telecommunications network.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (703) 306-3040. The examiner can normally be reached on Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harry S. Hong

Harry S. Hong
Primary Examiner
Art Unit 2642

March 31, 2005